

REMARKS

Claims 21-34 are currently pending, and claims 1-20 are cancelled.

Claims 21, 23, 24 and 28 were amended to address clarity and antecedent basis problems. No new matter was added with these amendments.

Claims 21-34 are rejected under 35 USC 103(a) for reasons of obviousness in view of Feathers (4,377,163) combined with Feder (5,267,815). However, Applicants submit that the Examiner has failed to present a prima facie case of obviousness for two reasons. First, the combination of Feathers with Feder does not teach or suggest all the limitations of the presently claimed invention, as required by MPEP § 2143 (03). And second, neither Feathers, the primary reference, nor Feder, the secondary reference, can be combined and modified to result in the currently claimed invention.

The instant claims require “a mounting means *for releasably engaging* a mounting portion of the cylinder”, such that “*in use*, the cylinder may be attached to the belt portion by both the mounting means and the retaining means *or else by the retaining means alone*” emphasis added. Feathers does not teach or suggest a mounting means that allows releasable engagement with a cylinder, in use. The Examiner’s position that the regulator valve in Feathers is a mounting means overlooks the important distinction that if the regulator releases the cylinder while the cylinder is in use, the breathing device no longer has a gas supply.

Similarly, Feder does not teach or suggest a mounting means that allows releasable engagement with a cylinder, in use. The retaining means of Feder, the holster, cannot be combined with the elements of Feathers to arrive at a harness with a mounting means and retaining means, wherein the cylinder, while in use, can be releasable engaged by the retaining means alone.

The present application relates to a harness 10 for use with a breathing apparatus. The harness comprises a shoulder panel 14 and a belt portion 16. The belt portion comprises attachment means which comprise a mounting means 28 and a retaining means 30. The mounting means is for releasably engaging a mounting portion 26 of a cylinder 17 and the retaining means is for retaining a retaining device 18 for the cylinder. The claim require that “*in use*, the cylinder may be attached to the belt portion by both the mounting means and the retaining means or else by the retaining means alone...” (see

claim 21, lines 6-8, emphasis added). This arrangement allows the cylinder of gas to be attached either close to a user (by the mounting means and the retaining means) or to be loosely suspended by the retaining means only. This may allow the user to move more freely, particularly through tight spaces.

In light of *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (April 30, 2007) (hereinafter “KSR”), there are a number of rationales upon which an examiner may support a conclusion of obviousness. Although the Examiner has not explicitly articulated which line of reasoning he is using to support the rejection, as required by MPEP § 2143, the Applicant assumes that the Examiner’s rationale is based on MPEP § 2143, rationale B) - simple substitution of one known element (Feder’s retaining means) for another (Feather’s mounting means) to obtain predictable results (Applicant’s claimed invention).

According to MPEP § 2143, para. B, “[t]o reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following: (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components; (2) a finding that the substituted components and their functions were known in the art; (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.”

However, as clearly stated in MPEP § 2143, para. B, “[i]f any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.”

Because the pending claims require that while “*in use*, the cylinder may be attached to the belt portion by both the mounting means and the retaining means or else by the retaining means alone...” Feathers and Feder cannot be combined and/or modified to obtain this required element. Doing so would “render the prior art unsatisfactory for its intended purpose” - being able to breath the gas in the cylinder – which is expressly disallowed in MPEP § 2143 (01) para. V. As stated there, and held by the Federal Circuit

Court in *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

As stated in the first paragraph of Feathers, the primary reference, “[t]he present invention relates to self-contained breathing apparatus....” The Examiner considers the regulator valve in Feathers to be a mounting means. Although the regulator in Feathers can releasably engage a cylinder, it is not possible to release the cylinder from the regulator while in use, since the breathing device would no longer have a gas supply.

The Examiner states that Feder discloses a retaining means, in the form of a cylinder holster, and believes that it would have been obvious to combine this feature with Feathers to arrive at the features of the presently claimed invention. However, combining the “retaining” means of Feder with the “releasable” mounting means (the regulator) of Feathers would not result in a harness for a cylinder that has a releasable mounting means and a retaining means, wherein the mounting means can be released while in use, allowing the cylinder to be retained only by the retaining means yet still provide gas to the user. Such a combination and modification to Feathers would result in an apparatus that would no longer be suitable for its intended purpose as a self-contained breathing apparatus because the user could not breathe if the mounting means (the regulator) in Feathers were released. Adding the holster of Feder as a retaining means would not cure this fatal defect in the combination.

Therefore, for at least the reasons outlined above, Applicants respectfully submit that there is no prima facie case for obviousness and therefore request withdrawal of the obviousness rejections under 35 USC 103(a).

CONCLUSION

Applicant submits that all the claims are now in condition for allowance, and early notice to that effect is respectfully requested. The Examiner is requested to telephone the undersigned if any matters remain outstanding so that they may be resolved expeditiously.

Applicants believe that no extension of time is required. However, in the event that an extension of time is required and extension fees are due, Applicants submit this conditional petition for an extension of time and request that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application.

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Respectfully submitted,

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